

Application/Control No. 09/925,650

Attorney Docket No. 10012445-1

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Double Patenting

It is respectfully submitted that the Applicant is willing to consider the filing of a terminal disclaimer, however, wishes to wait until either this application or one the below listed copending applications, issues, thus establishing which applications will be terminally disclosed with respect to which. In the interim, the double patenting rejection is provisionally traversed for at least the reason that it is not yet determined what the exact scope of the claims of each application will be at the time of their respective allowance. The double patenting rejection is also traversed in that the claims of this and the other three applications have been amended in a manner which is deemed to overcome the rejection.

- 1) 10012443-1 (084061-0165) 09/925,649 Advisory - Examiner Wallerson
- 2) 10012446-1 (084061-0166) 09/925,650 final rejection - Examiner Wallerson
- 3) 10004013-1 (084061-0136) 09/810,258 first action - Examiner Singh

IDS

An IDS which lists the above disclosed applications along with the art cited therein, is submitted with this response.

Claim Objections/Rejections under 35 USC § 112

In this response, claims the dependency of claims 10-13 has been changed. These claims now depend from claim 9 rather than 8. This overcomes the antecedent basis problems that have been noted in this Office Action.

Rejection under 35 USC § 101

Claim 20 has been revised to include a recitation of a computer readable medium. This amendment is submitted to overcome the rejection.

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Rejections under 35 USC § 102

The rejection under 35 USC §102(e) as based on Marx is (USP 6,348,970), is traversed.

The claims have been amended in a manner which clarifies over the arrangement disclosed in Marx. That is to say, the claims as amended call for information that is not contained in the print stream (i.e. a different document or material) to be inserted into the print stream to form a document. This is done by merging the document which is retrieved from the web with the print stream received by the printer, to form a modified document. This is submitted to be both different and distinct from the arrangement disclosed in Marx.

Rejection under 35 USC § 103

- 1) The rejection of claims 4, 7, 9-11 and 14-19 under 35 USC § 103(a) as being unpatentable over Marx in view of Kanoh et al. is respectfully traversed.

It is submitted that the teachings of Marx and Kanoh et al. when considered as a whole as statutorily required would not lead the hypothetical person of ordinary skill in the direction of the subject matter now claimed. By way of example, neither reference discloses nor suggests anything pertaining to obtaining documents and merging them with an original print stream to form another/modified document. Therefore, neither reference, when taken as a whole as statutorily required, contains any teaching that would provide the hypothetical person of ordinary skill with the necessary guidance to arrive at the claimed subject matter.

Merely by way of example, there is nothing in either document that remotely relates to the size of the information received (document length) or its ability to fit within the specified parameters into the original print stream.

- 2) The rejection of claim 5 under 35 USC § 103 as being unpatentable over Marx in view of Dutta, is respectfully traversed.

In this rejection it is stated that Marx does not clearly disclose retrieving data based on download time. To overcome this admitted shortcoming, Dutta is cited as disclosing a method of rendering network addresses of files capable of being

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downloaded over a network onto a printer. However, it appears that, while Dutta can list the amount of time necessary to download a file, there is no proper motivation for the hypothetical person of ordinary skill to consider the use of such listing with the arrangement of Marx. That is to say, the motivation alleged for the hypothetical person of ordinary skill to make the transfer is that it would "increase the types of identifying information disclosed by Marx." This hardly seems likely in that Marx is neither directed to displaying any such information nor to determining if a file should or should not be downloaded based on a given criteria, and is not therefore, in need of a list of size indicative data.

Listing the files in the order of download time is seen as being of no value whatsoever in Marx. That is to say, Marx is directed to retrieving various electronic documents from a computer network in response to received faxes. Further, the motivation has not been derived from the disclosure of either reference.

There are three possible sources for motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). This case law, however, establishes that, even if the combination of the references may possibly teach every element of the claimed invention, without a motivation to combine, a rejection attempting to establish a *prima facie* case of obvious must be held improper. Additionally, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

The rejection is untenable for at least this reason.

New Claim

A new independent claim 22 is added in this response. This claim is patentable over the art of record in at least it calls for the size of a document to be imported, to be determined. The claim then calls for the determination that this size is acceptable for merging into the print stream to form a modified document.

It is submitted that the art of record neither discloses nor suggests such a printing method. This new claim 22 is therefore allowable over the cited art.

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Conclusion

It is submitted that this application is in condition for allowance. Favorable consideration of the newly presented claims along with those rejected in this Office Action, are respectfully requested.

Respectfully submitted,

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